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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL S. NEVILLE and DAVID I. BERNKLAU HALVOR

Appeal 2009-007345
Application 10/648,414
Technology Center 2400

Before LANCE LEONARD BARRY, JOHN A. JEFFERY, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-22. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We Affirm.

BACKGROUND

Appellants' invention is directed to diagnostics and troubleshooting for computer peripheral devices, such as printers, in an environment where at least part of the diagnostic tool may be remotely located. (Spec. 1, 4-7).

Claim 1 is illustrative:

1. A method for performing diagnostics on a computer peripheral device, said method comprising:
 - coupling a computer executing a web browser to a backend server via a communication link;
 - constructing and sending a peripheral device HTTP message to said web browser from a web server executing in a peripheral device coupled to the computer, the peripheral device HTTP message comprising peripheral device functionality information;
 - forwarding said peripheral device HTTP message from said web server to said backend server;
 - constructing and transmitting from said backend server to said peripheral device one of a directive web page requesting more information from the peripheral device and a human readable web page that contains diagnostic results;
 - automatically responding to a directive web page received at the web server with another peripheral device HTTP message comprising functionality information; and

iteratively communicating between said backend server and said peripheral device until said human readable web page is constructed by said backend server.

The Examiner relies on the following prior art references as evidence of unpatentability:

Webb	US 5,727,135	Mar. 10, 1998
Wolff	US 6,209,048 B1	Mar. 27, 2001
Skaanning	US 6,879,973 B2	Apr. 12, 2007
Asauchi	US 7,013,410 B2	Mar. 14, 2006
Lozano	US 7,168,003 B2	Jan. 23, 2007

Appellants appeal the following rejections:

1. Claims 1-3, 5-9, 12-14, and 16-20 under 35 U.S.C. § 103(a) as unpatentable over Asauchi, Skaanning, and Wolff.
2. Claims 4 and 15 under 35 U.S.C. § 103(a) as unpatentable over Asauchi, Skaanning, Wolff, and Webb.
3. Claims 10, 11, 21, and 22 under 35 U.S.C. § 103(a) as unpatentable over Asauchi, Skaanning, Wolff, and Lozano.

Grouping of Claims

Based upon Appellants' arguments, we select claim 1 as representative of claims 1-3, 5-9, 12-14, and 16-20. We select claim 4 as representative of claims 4 and 15 (Supp. App. Br. 7). We also select claim 11 as representative of claims 11 and 22 (Supp. App. Br. 8). *See* 37 C.F.R. § 41.37(c)(1)(vii). We address claims 10 and 21 separately.

ISSUES

Based upon our review of the administrative record, we have determined that the following issues are dispositive in this appeal:

1. Under § 103, did the Examiner err in combining the cited references?
2. Under § 103, did the Examiner err in determining that the cited combination of references would have taught or suggested communicating between a backend server and a web server in a peripheral *through a browser executing in a computer coupled to the peripheral*? (Representative claim 1).
3. Under § 103, did the Examiner err in determining that the cited combination of references would have taught or suggested forwarding a peripheral device HTTP message from a web server to a backend server? (Representative claim 1).
4. Under § 103, did the Examiner err in determining that the cited combination of references would have taught or suggested a web server executing in a peripheral device? (Representative claim 1).
5. Under § 103, did the Examiner err in determining that the cited combination of references would have taught or suggested peripheral device functionality information with a PostScript function interface in response to a call from a web server? (Representative claim 4).
6. Under § 103, did the Examiner err in determining that the cited combination of references would have taught or suggested that peripheral device functionality information in the peripheral device HTTP message would have included data in XML format? (Representative claim 11).

FACTUAL FINDINGS

We adopt the Examiner's findings in the Answer and Final Office Action as our own, except as to those findings that we expressly overturn or set aside in the Analysis that follows. We add the following factual findings:

1. Appellants acknowledge that Skaanning discloses a system in which a customer uses a web browser executing in a computer. (App. Br. 9).
 2. Appellants acknowledge that Skaanning teaches a person can use a web browser to relay the content of messages received at the web browser, but not that the web browser alone relays the received messages. (Supp. App. Br. 4 and 7).
 3. Appellants acknowledge that Wolff discloses a peripheral that is provided with a web server. (Supp. App. Br. 5).
 4. Appellants acknowledge that Webb discloses a printer driver that may be implemented in PostScript. (Supp. App. Br. 7).
 5. Appellants acknowledge that Lozano discloses printer driver data is provided in an XML format from a printer vendor's database to a program executing on a client computer. (Supp. App. Br. 8).
- Additional findings of fact may appear in the Analysis that follows.

ANALYSIS

Issue 1

We decide the question of whether the Examiner erred in combining the cited references. Regarding claim 1, Appellants contend that the Examiner's use of Wolff is the result of using Appellants' Specification as a blueprint, which is impermissible. (App. Br. 11).

While we are fully aware that hindsight bias often plagues determinations of obviousness, *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966), we are also mindful that the Supreme Court has clearly indicated that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results,” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

At the outset, we observe the striking similarity between Wolff’s Figure 2 (depicting a peripheral 200 that includes a web server 202, connected over a network to a user web browser 204) and Appellants’ Figure 1 which depicts the claimed peripheral device (printer as shown in Fig. 1) containing a web server connected over a network to a personal computer with a web browser that accepts user input. The Examiner relies on Wolff as teaching or suggesting the use of the HTTP protocol where the responder program is a web server. (Ans. 4-5). We also note the striking similarity between Asauchi’s Figure 1 (depicting a computer 90 having a browser 10, a printer 20, and a support system server SV) and Figure 1 of Appellants’ invention on appeal.

Given these teachings, we are of the view that Appellants’ purported improvement over the prior art represents no more than the predictable use of prior art elements according to their established functions, and thus would have been obvious to one of ordinary skill in the art. *See KSR*, 550 U.S. at 417 (“[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” (citing *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976))).

Moreover, we are not persuaded that combining the respective familiar elements (e.g., peripheral device or printer, computer, browser, and servers) of the cited references in the manner proffered by the Examiner would have been “uniquely challenging or difficult for one of ordinary skill in the art” at the time of Appellants’ invention (*see Leapfrog Enters., Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007) (citing *KSR*, 550 U.S. at 418)). Therefore, we find the Examiner’s proffered combination of familiar prior art elements according to their established functions would have conveyed a reasonable expectation of success to a person of ordinary skill having common sense at the time of the invention.

Lastly, we note that Appellants have not rebutted the Examiner’s legal conclusion of obviousness by showing that the claimed combination of familiar elements produces any new function. Appellants have not provided any factual evidence of secondary considerations, such as unexpected or unpredictable results, commercial success, or long felt but unmet need.

Thus, when we take account of the inferences and creative steps that a person of ordinary skill in the art would have employed, we find the Examiner has articulated an adequate reasoning with a rational underpinning that reasonably supports the legal conclusion of obviousness. Thus, we are in accord with the Examiner that an artisan would have found it obvious to apply Wolff’s web server peripheral to Asauchi and Skaanning. (Ans. 4-5).

Therefore, we find Appellants’ arguments unavailing regarding the combinability of the cited references for essentially the same reasons proffered by the Examiner in the Answer, and for the reasons discussed above. Accordingly, we find the Examiner did not err by improperly combining the Asauchi, Skaanning, and Wolff references under § 103.

With respect to the remaining two rejections under §103, our reasoning discussed *supra* is similarly applicable.

Issue 2

We decide the question of whether the cited combination of references would have taught or suggested communicating between a backend server and a web server in a peripheral *through a browser executing in a computer coupled to the peripheral*, within the meaning of representative claim 1. (Supp. App. Br. 3).

Based upon our review of the record, we agree with the Examiner's findings with respect to the aforementioned limitation. (Ans. 7-8). In particular, we find unpersuasive Appellants' singular attack on the cited references (Supp. App. Br. 3-5). *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). In addition, as admitted by Appellants, Skaanning teaches a person can use a web browser to relay the content of messages received at the web browser. (FF 1; *see also* Ans. 4).

However, Appellants also contend that Asauchi and Skaanning do not teach or suggest sending a peripheral device HTTP message to the web browser and to the backend server. (Supp. App. Br. 4-5). We note that the Examiner relies on Wolff as teaching HTTP messages. (Ans. 8). We find decision block 311 (Fig. 3B and col. 5, ll. 5-25) of Wolff clearly evidences the notoriously well known use of the Hypertext Transfer Protocol (HTTP) on the World Wide Web in association with a web browser. Wolff also expressly teaches accessing a peripheral through a web browser. (Col. 8, l. 11). The Examiner relies on Asauchi's user support server system SV as teaching or suggesting the claimed backend server. (Ans. 5; *see also*

Asauchi, Figs. 1-3, col. 5, ll. 4-21). The Examiner's rejection is based on the *collective* teachings of the cited references. Therefore, we find unavailing Appellants' arguments attacking Asauchi and Skaanning in isolation.

On this record, we find no reversible error in the Examiner's determination that the combination of the cited references would have taught or suggested communicating between a backend server and a web server in a peripheral through a browser executing in a computer coupled to the peripheral, within the meaning of Appellants' representative claim 1.

Issue 3

We decide the question of whether the cited combination of references would have taught or suggested forwarding a peripheral device HTTP message from a web server to a backend server. (Representative claim 1).

Appellants contend that Skaanning does not teach forwarding the received message, only the content of the message. (Supp. App. Br. 4-5). However, Appellants acknowledge that Skaanning teaches a person can use a web browser to relay the content of messages received at the web browser, but not that the web browser alone relays the received messages. (FF 2).

We conclude that Appellants' representative claim 1 does not specify or otherwise limit what entity (e.g., machine or person or both) performs the step of forwarding.

Moreover, broadly providing an automatic way to replace a manual activity, which accomplished the same result, is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95 (CCPA 1958); *Leapfrog Enter., Inc.*, 485 F.3d at 1161. An improved product in the art is obvious if

that “product [is] not [one] of innovation but of ordinary skill and common sense.” *KSR*, 550 U.S. at 421.

For these reasons, we find no reversible error regarding the Examiner’s determination that the cited combination of references would have taught or suggested forwarding a peripheral device HTTP message from a web server to a backend server, within the meaning of representative claim 1. (*See* Ans. 4, 9-10).

Issue 4

We decide the question of whether the cited combination of references would have taught or suggested a web server executing in a peripheral device. (Representative claim 1).

Appellants contend that although Wolff discloses a peripheral is provided with a web server (FF 3), Wolff nevertheless teaches away from the present invention because the combination would result in the web server of the peripheral being coupled to the Internet for direct communication with the backend server to enable the backend server to control the peripheral remotely and iteratively obtain the necessary data for diagnosing the peripheral. Thus, Appellants aver that the web server browser and its operation would be superfluous and removed from the web system altogether. (Supp. App. Br. 6).

Based upon our review of the record, we do not agree that Wolff teaches away from Appellants’ claimed invention.

“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from

the path that was taken by the applicant.” *In re Kahn*, 441 F.3d 977, 990 (Fed. Cir. 2006) (citation and internal quotation marks omitted). *See also In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (noting that merely disclosing more than one alternative does not teach away from any of these alternatives if the disclosure does not criticize, discredit, or otherwise discourage the alternatives).

This reasoning is applicable here. Moreover, as pointed out by the Examiner (Ans. 11-12), the test for obviousness is not whether the features of a reference may be bodily incorporated into the structure of another reference, but rather what the combined teachings of those references would have suggested to one of ordinary skill in the art. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). For at least these reasons, we find Appellants’ teaching away argument unpersuasive.

Claims 1-3, 5-9, 12-14, and 16-20

For the reasons discussed above regarding Issues 1-4, we find no reversible error regarding the Examiner’s obviousness rejection of representative claim 1. Therefore, we sustain the Examiner’s rejection of claim 1 and claims 2-3, 5-9, 12-14, and 16-20 which fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Issue 5 – claims 4 and 15

We decide the question of whether the cited combination of references would have taught or suggested peripheral device functionality information with a PostScript function interface in response to a call from a web server, as recited in representative claim 4.

Appellants contend that “Webb only discloses a printer driver 55 that may be implemented in PostScript.” (FF 4; Supp. App. Br. 7). Appellants also contend that Webb discloses a print driver that does not respond to a call from a web server executing in a peripheral. (*Id.* at 7-8).

However, we observe that the Examiner relies upon Webb for teaching obtaining functionality information from a printer. (Ans. 6). While Appellants aver that “the tool bar interface [of Webb] is not a web server” (Supp. App. Br. 7), we note that Wolff’s Fig. 2 clearly teaches a web server 202 depicted inside a peripheral 200. Appellants again attack the references in isolation, when the Examiner’s legal conclusion of obviousness is based on the collective teachings of the cited references. (Supp. App. Br. 7-8).

Moreover, we are of the view that the Examiner’s proffered references are a combination of familiar elements (i.e., a PostScript print driver where printer configuration data is delivered to a printer interface) that would have taught or at least suggested the disputed limitation of claim 4. On this record, we find no reversible error regarding the Examiner’s underlying factual findings and ultimate legal conclusion of obviousness. Therefore, we affirm the Examiner’s § 103 rejection of claim 4 and claim 15 which falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Issue 6 – claims 11 and 22

We decide the question of whether the cited combination of references would have taught or suggested that peripheral device functionality information in the peripheral device HTTP message would have included data in XML format, within the meaning of representative claim 11.

Appellants aver that the portion of Lozano relied on by the Examiner does not disclose communication from a peripheral, but rather to a client program executing on a client computer coupled to a peripheral. (Supp. App. Br. 8). Appellants restate their argument that the Examiner has relied on impermissible hindsight in formulating the rejection. (Supp. App. Br. 9).

We find Appellants are again attacking the references in isolation, when the Examiner's legal conclusion of obviousness is based on the collective teachings of the cited references. (*See* Ans. 15-16). We find that Lozano clearly evidences the notoriously well known use of XML in the context of the printer art. (Col. 10, ll. 60-62). We find Appellants' arguments regarding hindsight unpersuasive for the reasons discussed *supra*.

On this record, we find no reversible error regarding the Examiner's underlying factual findings and ultimate legal conclusion of obviousness, as articulated on pages 15 and 16 of the Answer. Accordingly, we affirm the Examiner's § 103 rejection of claim 11 and claim 22 which falls therewith. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Claims 10 and 21

Because Appellants present no separate arguments for claims 10 and 21 (rejected by the Examiner as unpatentable over Asauchi, Skaanning, Wolff, and Lozano), we deem these arguments waived. *See* 37 C.F.R. § 41.37(c)(1)(vii). Accordingly, we affirm the Examiner's § 103 rejection of claims 10 and 21.

DECISION

We affirm the Examiner's § 103 rejections of claims 1-22.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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